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April 24, 2006

Date of Signature

PATENT
CASE NO. 10022/252-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application:)
George V. Guyan et al.) Group Art Unit: 2175
Serial No.: 09/305,146) Examiner: Rimell, S.
Filed: May 4, 1999)
For: COMPONENT BASED)
INFORMATION LINKING)
DURING CLAIM PROCESSING)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reasons stated on the attached sheets. No more than five (5) pages are provided.

REMARKS

A. 35 U.S.C. § 112, First Paragraph

In the Office Action of February 24, 2006, claims 22 and 41-65 were rejected under 35 U.S.C. § 112, first paragraph, for failing the written description requirement. In particular, claim 22 was rejected because the phrase "do not include functions performed by said event processor", as added in Applicants' Amendment of November 22, 2005, allegedly contained new matter.

Applicants traverse the rejection. To provide some context, claim 22 was amended to clarify that

the system responsibilities that are encapsulated by the event processor “do not include functions performed by said event processor” Such encapsulated system responsibilities are disclosed in Applicants’ original Specification at page 185 which states:

The Event Processor does not process any events itself and maintains clear encapsulation of system responsibilities. For example, an event that affects claim data is processed by the claim component.

Applicants’ original Specification at page 2 explains the concept of encapsulation as follows:

OOP [object oriented programming], therefore views a computer program as a collection of largely autonomous components, called objects, each of which is responsible for a specific task. This concept of packaging data, structures, and procedures together in one component or module is called encapsulation. (bracketed material added).

One of ordinary skill in the art would read the above two passages to mean that the embodiment of the event processor disclosed on page 185 and shown in FIG. 14 is compartmentalized in that it does not perform any of the functions regarding other components of the system for displaying information. Obviously, one of ordinary skill would understand that the event processor will perform the functions for which it is designed. Combining the two understandings above, one of ordinary skill in the art would find that there is support for the disputed amendment language at least in the two passages mentioned previously. Accordingly, the disputed amendment language does not constitute new matter and so the rejection should be withdrawn.

It is noted that the Office Action bases its rejection on the fact that the offending amended language is not disclosed in the original specification. However, the Office Action has failed to take into account that a lack of literal basis in the specification for a negative limitation may not be sufficient by itself to establish a *prima facie* case for a lack of descriptive support. *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993), MPEP § 2173.05(i).

On a related matter, the last paragraph at page 2 of the Office Action asserts that Applicants’ failure to assert that the offending amended language was not new matter was evidence that the language was new matter. There is no legal basis for such an assertion. Indeed, Applicants previously amended claim 22 in their Amendment of May 31, 2005 to clarify that the event

processor “maintains clear encapsulation from responsibilities.” Page 8 of the May 31st Amendment specified that the amendment was supported by at least page 185 of the specification. The Office Action mailed on August 23, 2005 did not dispute that there was support for the amendment. Since the offending amended language presented in Applicants’ Amendment of November 22, 2005 was a rephrasing of the amended language of May 31, 2005 (which was not deemed to be new matter) and was not intended to change its intended scope or meaning, the offending amended language is not new matter. MPEP § 2163.07 I.

It is noted that claims 22 and 41-65 have not been rejected based on the prior art. Since the rejections of claims 22 and 41-65 have been shown to be improper, the claims should be allowed. Furthermore, the Office Action has not rejected the claims under 35 U.S.C. § 112, second paragraph, and so the Examiner has conceded that the claims are clear in meaning (see first paragraph of Remarks Section at page 4 of the Office Action) and that a prior art search of the claims was possible at the time of mailing of the Office Action. The absence of a rejection based on the prior art can only mean that the Examiner has not found any art that would render the claims unpatentable. See MPEP § 2163.06 I. Accordingly, there is no need to remand the case back to the Examiner for a further search.

B. 35 U.S.C. § 102

1. Claim 66

Claim 66 was rejected under 35 U.S.C. § 102(e) as being anticipated by Borghesi et al. Applicants traverse this rejection. In particular, claim 66 recites a system that displays insurance claim information that includes a server that allows each of the users of a user interactive interface “to simultaneously interact with one of the plurality of levels to retrieve and enter data for the same insurance claim.” The Office Action has asserted that “[a]ny one of the users at the computers (30 or 32 or 34) can interact with the levels of the claim folder to retrieve data of the folder and enter data into the folder.” The Office Action, for the first time, asserts that FIGS. 2-3 disclose that a claims folder is accessible to computer 30, 32, 34 via server 36. A review of FIGS. 2-3 does not disclose each of the users of computers 30, 32, 34 simultaneously interacting with a level to retrieve/enter data for an insurance claim. The Office Action also asserts that “in any client-server configuration, access to data by the client does not lock out access to that data by the other clients.” However, the Office Action has not cited one passage of Borghesi et al. that discloses such a client-server configuration. Indeed, it is apparent that the rejection is based on incorporating attributes to

Borghesi et al. that simply are not explicitly or inherently present in the reference. This is improper.
Glaverbel S.A. v. Northlake Mkt'g & Supp., Inc., 45 F/3d 1550, 33 USPQ2d 1496 (Fed. Cir. 1995)..

Borghesi et al. also fails to disclose matching determined claim characteristics to tasks “to automatically generate a list of tasks to be taken by any one of the plurality of users” as recited in claim 66. In other words, Borghesi et al. does not disclose a system that determines claim characteristics that are used to automatically generate a list of tasks. The Office Action refers to the actions 220-230 shown in FIG. 8F as disclosing the recited list of tasks. However, FIG. 8F is merely a flow diagram showing a preferred workflow (Col. 3, ll. 49-50). Nowhere does Borghesi et al. disclose that a list of items 220-230 shown in FIG. 8F is automatically generated. Furthermore, Borghesi et al. does not disclose automatically generating the list of items 220-230 based on a determination of claim characteristics. The Office Action asserts for the first time that:

FIGS. 8E through 8F illustrate that when a user selects the “create/edit” data function in FIG. 8E, this selection automatically generates a series of tasks that have to be performed according to the sequence defined in FIG. 8F. These steps are triggered by a determination of claim characteristics, such as defined by step 202. Step 220 can also be read as the identification of a claim characteristic. Identifying the characteristic then automatically triggers the generation of tasks, according to the define flow chart in FIG. 8F. This list of tasks is not suggested as being triggered manually or randomly, since the flow chart of FIG. 8F defines both the tasks themselves and the exact sequence in which they must be followed.

The above assertion is imaginative to say the least. Borghesi et al. does not disclose that a user select a “create/data” function 202. Instead, item 202 is an information process that can be performed by a user, via a graphic user interface for example. (Col. 12, ll. 3-13). That process can include any of the processes shown in FIG. 8F. The processes are done voluntarily by a user by entering information via a keyboard. (Col. 12, ll. 14-36). There is nothing in Borghesi et al. that discloses the processes of FIG. 8F are automatically generated or generated by claim characteristics. Furthermore, no list of tasks is generated. FIG. 8F is merely a flow chart that helps the reader of the patent to understand processes that can be performed by a user. The flow chart is not itself generated by the system of Borghesi et al.

Finally, the Office Action asserts that the processes of FIG. 8F must be done automatically since it defines tasks and an “exact sequence in which they must be followed.” The assertion has

no merit. Using such logic would mean that a recipe for a food dish must be performed automatically since the recipe defines tasks and gives the exact sequence that the tasks must be performed. Furthermore, the assertion ignores Borghesi et al.’s own disclosure which states a user manually enters information via a keyboard for performing the processes of FIG. 8F. (Col. 12, ll. 14-16).

2. Claim 67

Claim 67 was rejected under 35 U.S.C. § 102(e) as being anticipated by Borghesi et al. Applicants traverse this rejection. In particular, claim 67 recites a system that displays insurance claim information that includes a plurality of interfaces that allow a plurality of users “to simultaneously interact with one of the plurality of levels to retrieve and enter data on the same insurance claim.” The Office Action has asserted that “[a]ny one of the users at the computers (30 or 32 or 34) can interact with the levels of the claim folder to retrieve data of the folder and enter data into the folder.” The Office Action, for the first time, asserts that FIGS. 2-3 disclose that a claims folder is accessible to computer 30, 32, 34 via server 36. As stated above in Section B.1, the assertion has no merit. Accordingly, claim 67 is not anticipated by Borghesi et al.

Borghesi et al. also fails to disclose an event processor that “determines a response for the data event and identifies a system component to process the response and transmits information for processing the claim to the identified system component” as recited in claim 67. The Office Action has failed to specifically identify any element in Borghesi et al. that corresponds to the above mentioned event processor. While page 4 of the Office Action mentions an event processor in conjunctions with FIG. 8E, the drawings does not show a processor. Evidently Borghesi et al. fails to disclose the recited event processor. Accordingly, Borghesi et al. does not anticipate claim 67.

Note that Applicants also repeat their objections above in Section B.1. to those arguments in the Office Action regarding claim 66 which have been applied to claim 67 as well.

Respectfully submitted,



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